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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/584,805	05/31/2000	Peter M. Redling	K41-002 US	2289

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EXAMINER

MANNING, JOHN

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/584,805	Applicant(s) REDLING ET AL.	
	Examiner John Manning	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 18-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 18-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed with respect to the amended claims have been fully considered but they are not persuasive.

The applicant argues "In the sections referred to by the Examiner, Schein is designed to work with a PCTV which is a 'television coupled to a computer system' (see paragraph 72). By contrast, the present invention as claimed in claim 1 is designed to work with a set-top box only and not a computer attached to the set top box." The system of Kitsukawa is a set-top box with no computer attached (as evidenced by Figure 2). Schein is relied upon for evidentiary that it is well known to display advertising information regarding items independent to the displayed television program so that the user could be provided with a greater variety of advertisements and also advertisements based on other determinative factors.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11 and 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitsukawa et al. in further view of Shoff et al and Schein et al.

Regarding claim 1, Kitsukawa shows a method of providing advertising to a subscriber through a set top communications box connected to a television (Col 2, Lines 18-61; Fig 2, Item 39), the method comprising transmitting icons and associated advertising information to the set top communications box (Col 6, Lines 40-64), displaying an icon on the television program (Col 7, Lines 10-20; Col 8, Lines 18-36), detecting an input signal indicating the icon has been selected with the set top box (Col 7, Lines 20-40), retrieving the advertising information associated with the icon, and displaying the advertising information on the screen (Col 7, Lines 20-40). Although Kitsukawa suggests that this system could be connected to a computer network (Col 4, Lines 55-67), the reference fails to specifically state that this is a global computer network and that icons and advertising information are stored on a server connected to the global computer network. Shoff shows a set top communications box connected to a global computer network. This global communications network stores advertising information and related information on a server (Page 2, Sections 0015, 0029; Page 3, Sections 0031, 0035; Page 4, Sections 0047-0048). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Kitsukawa with the ability to connect to a global computer network so that the system would have access to a wide variety of data that could be displayed on the user's screen. Both Kitsukawa and Shoff fail to specifically state that the icon and advertising information are independent of a television program being displayed. Schein shows that the icon and advertising information can be independent of a television program being displayed (Page 9 sections 0074-0075). Schein shows that a user can be displayed

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advertising information for Budweiser merchandise while watching a sports event. The advertising is therefore unassociated with the program, which is a sporting program. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Kitsukawa and Shoff with the ability to display advertising information regarding items independent to the displayed television program so that the user could be provided with a greater variety of advertisements and also advertisements based on other determinative factors.

Regarding claim 2, Kitsukawa shows that the advertising information is displayed in a distinct frame in the screen (Col 7, Lines 20-40).

Regarding claim 3, Kitsukawa shows superimposing an icon over a television program (Col 7, Lines 10-21; Col 8, Lines 15-50).

Regarding claim 4, Kitsuka shows that if a user does not input a response to one icon, a second icon for another item is shown after a period of inactivity (Col 7, Lines 40-60).

Regarding Claim 5, Kitsukawa, Shoff, and Schein fail to specifically state the length of time that elapse between the display of a first icon and the display of a second icon. Official Notice is given that it is well known and expected in the art to use a variety of time lengths between displaying successive itmes. This allows enough time for the user to select the icon, but not too much time in the event the user is not interested in the current icon and is waiting for the next. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Kitsukawa, Shoff, and Schein with the 1 to 5 minute duration so that a user would be

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provided with new icons in a timely manner in the event the user is not interested in the present icon.

Regarding Claim 6, Kitsukawa shows transmitting advertising information to the memory of the set-top box for display on the user's screen and following detecting on of the icons has been selected, transmitting the advertising information to the set-top box (Col 6 Lines 6- 17 and 40-65; Col 7, Lines 10-52).

Regarding Claim 7, Shoff shows a variety of display methods, including displaying advertising data in the main portion of the screen in place of television program data (Page 6, Sections 0068, 0069, 0076; Page 7, Sections 0077, 0078, Fig 8c).

Regarding Claim 8, Kitsukawa shows transmitting advertising information to the memory of the set-top box for display on the user's screen and following detecting one of the icons has been selected, transmitting the advertising information to the set-top box (col. 6 lines 6-17, 40-65, col. 7 lines 10-52).

Regarding Claim 9, Kitsukawa shows that if a user does not input a response to one icon, a second icon for another item is shown after a period of inactivity (col. 7 lines 40-60).

Regarding Claim 10, Kitsukawa, Shoff and Schein fail to specifically state the length of time that elapse between the display of a first icon and the display of a second icon. Official Notice is given that it is well known and expected in the art to use a variety of time lengths between displaying successive items. This allows enough time for the user to select the icon, but not too much time in the event the user is not interested in

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the current icon and is waiting for the next. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Kitsukawa, Shoff, and Schein with the 1 to 5 minute duration so that a user would be provided with new icons in a timely manner in the event the user is not interested in the present icon.

Regarding Claim 11, Kitsukawa shows superimposing an icon over a television program (Col 7, Lines 10-21; Col 8 Lines 15-50).

Regarding claim 18, the recited limitations are met by that discussed above for claim 1 (Also, see Col 6, Lines 51-60; Col 7, Lines 10-20; Col 8, Lines 18-36; Col 7, Lines 20-40). Specifically, the claimed limitations of "downloading by a set-top box an advertising icon from an advertising server through the Internet" and "downloading by the set-top box an advertising information associated with the advertising icon from the advertising server through the Internet" are met by Figures 2 and 4. "The advertising information may be received simultaneously with the scenes in which the identified items corresponding to the advertising information appear, but the embodiment is not so limited. Furthermore, the advertising information may be received prior to receipt of the scenes or television programs in which the identified items corresponding to the advertising information appear, in which case the advertising information is stored along with timing data that links the advertising information to the corresponding scene or program" (Col 6, Lines 51-60).

Regarding Claims 19-20, Kitsukawa shows the icon has an associated link pointing to the associated advertising information, the step of downloading by the set-

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top box an advertising icon includes requesting a download of the associated advertising information from the advertising server using the associated link when the user has selected the displayed icon, the step of downloading by the set-top box an advertising icon includes: after the user selection is received, requesting a download of the associated advertising information from the advertising server; and receiving the requested advertising information by the set-top box (Col 8, Lines 49-57).

Regarding claim 21, Kitsukawa shows displaying the advertising information includes displaying the television program being displayed on the television screen in a first frame and displaying the advertising information in a second frame different from the first frame (Col 9, Lines 38-41; Figure 6).

Regarding claim 22, Kitsuka shows that if a user does not input a response to one icon, a different icon for another item is shown after a period of inactivity (Col 7, Lines 40-60).

Regarding claim 23, the recited limitations are met by that discussed above for claim 1 (Also, see Paragraphs 0052 and 066; Figure 5, Item 100 of Schein)

Regarding claim 24, Kitsuka shows after the user selection is received from the input device, the processor requests a download of the associated advertising information from the advertising server and receives the requested advertising information for display on the television screen (Col 8, Lines 49-57).

Regarding claim 25, Kitsuka shows the processor displays a different icon on the television screen when no user selection is received from the input device for a selected period of time (Col 9, Lines 38-41, Figure 1 and 6).



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Regarding claim 26, Kitsuka shows that if a user does not input a response to one icon, a different icon for another item is shown after a period of inactivity (Col 7, Lines 40-60).

***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Manning whose telephone number is 571-272-7352. The examiner can normally be reached on M-F: 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM  
October 15, 2002

  
**JOHN MILLER**  
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